

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT EXAMINING OPERATION

First Named Inventor: Margaret A. WHEATLEY

Serial No: 10/805,703

Group Art Unit: 1618

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Examiner: Leah H. SCHLIENTZ

Att. Docket No.: D2027/20140

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For: ISOLATED NANOCAPSULE POPULATIONS AND SURFACTANT-STABILIZED
MICROCAPSULES AND NANOCAPSULES FOR DIAGNOSTIC IMAGING AND
DRUG DELIVERY AND METHODS FOR THEIR PRODUCTION

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated February 20, 2007, favorable reconsideration is respectfully requested in view of the following remarks.

Claims 1-20 are pending.

ELECTION/RESTRICTION

In response to the restriction requirement, Applicants hereby provisionally elect Group III, claims 4-10, 19, and 20, drawn to a microcapsule or nanocapsule for diagnostic imaging. This provisional election is made with traverse.

Claims 1, 2, 3, 4-10, 19 and 20 are encompassed by this election. Claim 4 is a product – by-process claim. Claims 2 and 3 are directed to a method for producing surfactant-stabilized microcapsules and nanocapsules, wherein claim 3 depends from base claim 2. Claim 1 is directed to a method of isolating nanobubbles or nanocapsules from a mixed population of nanobubbles or nanocapsules. While claim 1 can be used to isolate nanobubbles or nanocapsules which are not necessarily surfactant-stabilized as in claims 2 and 3, it can represent a step further limiting the process of claim 2, i.e., claim 3.

A restriction requirement between inventions is proper only where there is a serious burden on the Patent Office to examine all of the claims in a single application, even when it appears that appropriate reasons exist for a restriction requirement. MPEP §803. Applicants

respectfully submit that there would be no serious burden on the Patent Office to examine at least claims of Groups I and II together with claims of Group III because the subject matter of Groups I-III is sufficiently related such that a search of any one group would encompass a search for the subject matter of the remaining group. Thus, the restriction requirement is improper and should not be maintained.

Also, claim 4 is a linking claim for Groups I-IV. Products of Group III relate to a contrast agent used for diagnostic purposes and products of Group IV relate to a bioactive agent used for therapeutic purposes. Since claim 4 will already be examined with or without targeting agents (e.g., claim 6), Applicants respectfully request that upon the allowance of linking claims, the restriction requirement will be withdrawn and restricted claims of Group IV will be rejoined for further examination.

Accordingly, reconsideration and withdrawal of the restriction requirement are respectfully requested.

Applicants reserve their rights under 35 USC § 121 to file a divisional application for the non-elected claims.

Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
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March 20, 2007

Please charge or credit our
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consideration of this submission.